

**REMARKS**

Claims 1, 3-5, 7, and 10-22 remain in this application. Claim 22 is newly added. Applicant requests continued examination. A formal RCE request is submitted herewith.

Claims 1 and 3 were rejected as anticipated by a European Patent (EP 0135595). Applicant respectfully traverses.

The European Patent (EP 0135595) is directed to a method for manufacturing a floor covering for sport grounds and sports halls. The floor covering is made of rubber granules, “Gummigranulat,” or rubber waste, “Gummiabfällen,” or a combination of both, combined with a prepolymer bonding agent (page 3, lines 1-3). The rubber and bonding agents are then pressed into continuous sheets until the sheet hardens. The sheet is then cut into sections and rolled up for distribution (page 3; Fig 1). The European Patent does not contemplate a porous floor covering, let alone a variable porosity for the floor covering. Use of the floor covering on sport grounds and sport halls indicates that the floor covered is not porous.

The European Patent does not disclose nor suggest a mixture of butadiene rubber granules and peelings or buffings, much less an arrangement whereby “the first weight percentage of the butadiene rubber granules varying relative to the second weight percentage of peelings or buffings to increase the porosity of the base layer depending on tree density around the sidewalk.” The European Patent is directed to athletic venues like sport halls, and not the environment. As such, it does not contemplate varying the weight ratio of butadiene rubber granules to peelings or buffing to increase porosity in order to benefit tree density and vegetation in its vicinity.

For at least these reasons, Applicant respectfully submits that Claim 1, as amended herein, is patentable over the European Patent. Claim 3 depends from Claim 1 and is deemed

patentable at least by the virtue of this dependence. New Claim 22 is deemed patentable over the European Patent for at least the reasons stated above for Claim 1.

Applicant respectfully requests that the rejection be withdrawn.

Claims 4-5 were rejected as obvious over the European Patent in view of Patent No. 6,602,586 to *Kakimoto* et al. (“*Kakimoto*”) or in view of Publication No. 2003/0091831 to *Mickey*. Applicant respectfully traverses.

The European patent fails to disclose or suggest a mixture of butadiene rubber granules and peelings or buffings, much less an arrangement whereby “the first weight percentage of the butadiene rubber granules varying relative to the second weight percentage of peelings or buffings to increase the porosity of the base layer depending on tree density around the sidewalk.” *Kakimoto* and *Mickey* fail to cure this deficiency.

*Kakimoto* is directed to elastic blocks for use as pavement material. At Fig. 2, the reference shows elastic block 11 with vulcanized rubber layer 13 and rubber containing-layers 12a and 12b. The rubber-containing layer 12a has elastic chips 12c and the rubber-containing layer 12b has elastic chips 12d. Elastic chips 12d are about 0.5-10 mm in diameter and elastic chips 12c are about the same size or smaller than elastic chips 12d. *Kakimoto* does not disclose nor suggest using butadiene rubber granules and peelings or buffings, much less vary the porosity of the elastic block by varying the weight ratio of the rubber granules to the peelings or buffings.

*Mickey* is directed to an animal floor system. In Figs. 1-3, *Mickey* discloses animal handling area 10 having base 20 made from concrete, asphalts, sand, stone, sawdust, mulch, etc. Rubber sub-coat 30 and rubber topcoat 40 are formed over base layer 20. The reference discloses that granulated rubber, such as styrene butadiene (SBR) or ethylene propylene diene

M-class rubber (EPDM) granules can be used. The reference does not contemplate varying porosity, much less varying porosity by varying the relative percentages of butadiene rubber granules relative to peelings or buffings. A combination of the European Patent and *Mickey* fails to render the invention of Claim 1 unpatentable. Claims 4 and 5 are deemed patentable at least by the virtue of their dependence from Claim 1.

With respect to Claim 5, the Office Action acknowledges that even if the European Patent was modified in view of *Kakimoto* and *Mickey*, it would still “not disclose the ratio of binder to rubber is 16% by weight.” Office Action, page 4. Nonetheless, the Office Action concludes that this limitation could be found by mere experimentation.

Applicant respectfully disagrees with this conclusion. The Office Action is impermissibly applying the so-called obvious to try rational in support of an obviousness rejection. To predicate obviousness on the obvious to try rational, the Office Action must first establish that the references were teaching each and every element of the invention and that varying a specific parameter (here, a 16 wt. % ratio of the first binder to butadiene) would have been a matter of routine experimentation. See, e.g., M.P.E.P. §2145(X) and *In re O'Farrell*, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988). Claim 1 recites a structure in which the ratio of butadiene granules to peelings or buffings is varied in order to change porosity of the structure to render it more suitable for its environment. The references do not disclose nor suggest these limitations. Nor do they provide a detailed enabling methodology or a suggestion to modify its teaching to arrive at the claimed invention. Accordingly, Claim 5 is patentable over the European Patent in view of *Kakimoto* on this additional ground.

Applicant respectfully requests that the rejection be withdrawn.

Claim 7 was rejected as unpatentable over the European Patent in view of Patent No. 5,396,731 to *Byrne*. Applicant respectfully traverses.

*Byrne* discloses a mulch pad for use around trees. The mulch pad 10 is designed to be flexible, so that it can be shaped and placed around a tree 12 through a pre-cut slit 18 (column 3, lines 67-68; column 4, lines 1-16). The pad is composed of rubber granules from used tires and rubber buffings combined in a latex or urethane binder (column 3, lines 17-27). The mulch pad 10 is not made of materials that could be utilized as a sidewalk. The mulch pad 10 is not designed to support foot and bicycle traffic.

*Byrne* does not disclose or contemplate a combination of butadiene rubber granules and peelings or buffings. *Byrne* does not disclose or contemplate a variable combination of butadiene rubber granules and peelings or buffings much less selecting a weight ratio of granules and peelings or buffings to increase porosity. For at least this reason, *Byrne* does not cure deficiencies of the European Patent as outlined above in relation to Claim 1. Dependent Claim 7 is deemed patentable over the European Patent and *Byrne* at least by the virtue of its dependence on Claim 1.

Withdrawal of the rejection is respectfully requested.

Claims 10-14 were rejected as unpatentable over the European Patent. Applicant respectfully traverses.

With respect to claims 10-12, the Office Action states that while the European Patent does not disclose the mixture of granules to peelings or buffing in the claimed range, it would have been obvious to vary the ratio “so as to allow for the device to be of a natural appearance.” Office Action at page 5. To be “of a natural appearance” is not an objective of the claimed invention. Claims 10-11 recite different ratios of granules to peelings or buffings to increase

porosity of the combination. The European Patent does not disclose nor suggest varying the weight percentage of the granules relative to the rubber peelings or buffings to increase the porosity. Absent specific teachings in the reference, a mere allegation that it would have been obvious to try, does not establish a *prima facie* case of obviousness. Each of the claims 10-14 depends from Claim 1 and is deemed patentable over the reference at least by virtue of its dependence on a patentable claim.

Applicant requests that the rejection of claims 10-14 be withdrawn.

Claims 15-18 were rejected as unpatentable over the European Patent in view of *Kakimoto* or *Mickey*. As discussed above, a combination of the European Patent with *Kakimoto* or *Mickey* fails to disclose or suggest Claim 1. Claims 15-18 depend from Claim 1 and are deemed patentable at least by the virtue of this dependence.

Applicant requests that this rejection be withdrawn.

Claim 19 was rejected as unpatentable over the European Patent in view of Patent No. 4,205,102 to *Schuurink, et al.* (“*Schuurink*”). Applicant respectfully traverses.

*Schuurink* discloses polyisocyanate and a polycaprolactone polyol having a molecular weight of 250 to 3500. *Schuurink* fails to cure deficiencies of the European Patent as identified above. Accordingly, a combination of the European Patent and *Schuurink* fail to render Claim 1 unpatentable. Claim 19 depends from and further limits Claim 1, and is allowable for at least the same reasons given above for the patentability of Claim 1.

Applicant requests that this rejection be withdrawn.

Claim 20 was rejected as unpatentable over the European Patent in view of *Schuurink* and further in view of *Byrne*. Applicant respectfully traverses. As discussed above, neither *Schuurink* nor *Byrne* cure deficiencies of the European Patent.

Claim 20 depends from and further limits Claim 19, and is deemed allowable for at least the same reasons given above for the patentability of claims 19 and 1.

Applicant respectfully requests that this rejection be withdrawn.

Claim 21 was rejected as unpatentable over the European Patent. Claim 21 depends from Claim 1 and further narrows the scope of Claim 1. Claim 21 is deemed allowable at least by the virtue of this dependence.

Applicant requests that this rejection be withdrawn.

Claims 1-3, 6-14 and 21 stand rejected as allegedly unpatentable over Patent No. 6,818,278 to *Blythe* in view of *Byrne*. Applicant respectfully traverses.

*Blythe* is directed to construction materials used as a wearing course for children's play areas, athletics, and horse riding. *Blythe*'s wearing course is composed of thermoplastic elastomer particles bound in a liquid binder. *Blythe* discloses that the thermoplastic elastomer particles in the composition are bound in direct contact with one another (column 2, lines 39-55). *Blythe* specifies that the particles have the shape of "angular granules" in order to bind properly in direct contact with one another (column 2, lines 39-55). *Blythe* does not disclose a combination of butadiene rubber granules and peelings or buffings. Moreover, *Blythe* does not disclose a porous base layer. *Blythe* does not contemplate varying the combination of butadiene rubber granules and peelings or buffings to vary the porosity of a base layer as claimed in Claim 1.

As discussed above, *Byrne* does not cure *Blythe*'s deficiencies. Neither reference even contemplates increasing porosity to suit the environment, much less disclose varying the weight percentage of butadiene rubber granules relative to the peelings or buffings to increase porosity. Applicant submits that Claim 1 is patentable over *Blythe* in view of *Byrne*.

Claims 6 and 8-9 have been cancelled.

Claims 3, 7, 10-14 and 21 depend from Claim 1 and are deemed patentable at least by the virtue of this dependence.

Applicant requests that this rejection be withdrawn.

Claims 4-5 and 15-18 were rejected as unpatentable over *Blythe* as modified by *Byrne* and further in view of *Kakimoto* or *Mickey*. Applicant respectfully submits that Claim 1, is patentable over the combination of the references. As discussed, *Blythe* and *Byrne* do not disclose nor suggest varying the weight percentage of butadiene rubber granules relative to the peelings or buffings. *Kakimoto* or *Mickey* fail to cure this deficiency for at least the reasons discussed above. Claims 4-5 and 15-18 depend from and further limit the scope of claim 1. Accordingly, Claims 4-5 and 15-18 are deemed patentable at least by the virtue of this dependence.

Applicant respectfully requests that the rejection be withdrawn.

Claims 19-20 were rejected as unpatentable over *Blythe* as modified by *Byrne* and further by *Schuurink*. Neither *Blythe* or *Byrne* disclose varying the combination of butadiene rubber granules and peelings or buffings to increase or decrease the porosity of a base layer for a sidewalk, as recited in Claim 1. *Schuurink* does not cure this deficiency for the reasons proffered above. Accordingly, a combination of *Blythe*, *Byrne* and *Schuurink* fails to render the invention of Claim 1 unpatentable. Claims 19-20 depend, either directly or indirectly, from Claim 1 and are deemed patentable at least by the virtue of this dependence. Applicant respectfully submits that Claims 19-20 are patentable over a combination of *Blythe*, *Byrne* and *Schuurink*.

Applicant respectfully requests that this rejection be withdrawn.

For the foregoing reasons, Applicant submits that claim 1, and all claims depending from claim 1, are in condition for allowance. New Claim 22 is deemed allowable over the art of record for at least the reason that it contains the novel features of Claim 1.

In view of the above amendment and remarks, applicant submits that all the claims are allowable, requests that they be allowed and this application passed to issue.

Sincerely yours,

**SNELL & WILMER L.L.P.**



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